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1652 #

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/751,299	
	Filing Date	December 28, 2000	
	First Named Inventor	Mark MADDEN	
	Art Unit	1652	
	Examiner Name	K. Kerr	
Total Number of Pages in This Submission	17	Attorney Docket Number	564462006600

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	Processing Fee Under 37 CFR 1.17(i) Transmittal (1 page + duplicate for fee processing)
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	Request for Correction of Inventorship (2 pages)
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	Statement in Support of Petition to Correct Inventorship signed by Dan E. ROBERTSON (1 page)
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application		Declaration for Patent Application with power of attorney (4 pages)
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		Consent of Assignee, etc. (1 page)
		A copy of the executed Assignment to Diversa Corporation (3 pages)
		Initial Application Data Sheet (3 pages)
		Return Receipt Postcard
<div>Remarks</div> <div>Customer No. 45975</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Laurie L. Hill, Ph.D.		
Date	February 11, 2005	Reg. No.	51,804

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: February 11, 2005

Signature: (Grace Yu)



PROCESSING FEE Under 37 CFR 1.17(i) TRANSMITTAL (Fees are subject to annual revision) Send completed form to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	09/751,299
	Filing Date	December 28, 2000
	First Named Inventor	Mark MADDEN
	Art Unit	1652
	Examiner Name	K. Kerr
	Attorney Docket Number	564462006600

Enclosed is a paper filed under 37 CFR _____ §1.48(a) that requires a processing fee (37 CFR 1.17(i)).
Payment of \$ 130.00 is enclosed.

This form should be included with the above-mentioned paper and faxed or mailed to the Office using the appropriate Mail Stop, if applicable. For transmittal of petition fees under 37 CFR 1.17(f), (g) or (h), see form PTO/SB/17p.

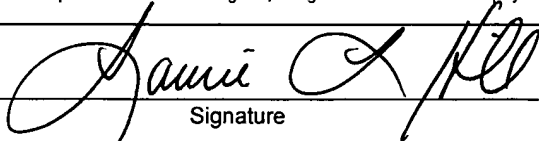
Payment of Fees (small entity amounts are NOT available for the petition fees)

- ☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 03-1952 :
- ☒ Processing fee under 37 CFR 1.17(i) ☒ Any deficiency of fees and credit of any overpayments
- Enclose a duplicative copy of this form for fee processing.
- ☐ Check in the amount of \$ _____ is enclosed.
- ☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

Processing Fees under 37 CFR 1.17(i): Fee \$130 **Fee Code 1808 for all,**
Except for \$1.221 papers (Fee Code 1803)

For papers filed under:

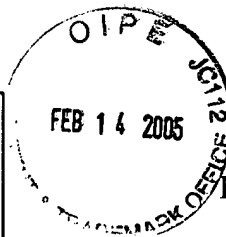
- § 1.28(c)(3) – for processing a non-itemized fee deficiency based on an error in small entity status.
- § 1.41 – for supplying the name or names of the inventor or inventors after the filing date without an oath or declaration as prescribed by §1.63, except in provisional applications.
- § 1.48 – for correcting inventorship, except in provisional applications.
- § 1.52(d) – for processing a nonprovisional application filed with a specification in a language other than English.
- § 1.53(b)(3) – to convert a provisional application filed under § 1.53(c) into a nonprovisional application under §1.53(b).
- § 1.55 – for entry of late priority papers.
- § 1.99(e) – for processing a belated submission under § 1.99.
- § 1.103(b) – for requesting limited suspension of action, continued prosecution application (§ 1.53(d)).
- § 1.103(c) – for requesting limited suspension of action, request for continued examination (§ 1.114).
- § 1.103(d) – for requesting deferred examination of an application.
- § 1.217 – for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.
- § 1.221 – for requesting voluntary publication or republication of an application. **Fee Code 1803**
- § 1.291(c)(5) – for processing a second or subsequent protest by the same real party in interest.
- § 1.497(d) – for filing an oath or declaration pursuant to 35 U.S.C. 371(c)(4) naming an inventive entity different from the inventive entity set forth in the international stage.
- § 3.81 – for a patent to issue to assignee, assignment submitted after payment of the issue fee.

 _____ Signature	February 11, 2005 _____ Date
Laurie L. Hill, Ph.D. _____ Typed or printed name	51,804 _____ Registration No., if applicable

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: February 11, 2005 Signature: _____

(Grace VA)



Docket No.: 564462006600
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mark MADDEN et al.

Application No.: 09/751,299

Confirmation No.: 8629

Filed: December 28, 2000

Art Unit: 1652

For: METHODS FOR PRODUCING ALPHA-SUBSTITUTED CARBOXYLIC ACIDS
USING NITRILASES AND STRECKER
REAGENTS (AS AMENDED)

Examiner: K. Kerr

REQUEST FOR CORRECTION OF INVENTORSHIP
PURSUANT TO 35 U.S.C. 116 & 37 C.F.R. § 1.48(A)

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The presently named applicants, Darcy MADDEN (Heir to Mark MADDEN, deceased), David Paul WEINER, and Jennifer Ann CHAPLIN hereby petition the Assistant Commissioner to amend the above captioned application to add the name of Dan E. ROBERTSON as joint inventor. Enclosed are the following:

1. A statement from each person being added as inventor that the error in inventorship occurred without deceptive intent on his/her part. Dan E. ROBERTSON is the only added inventor.
2. An oath or declaration by the actual inventor or inventors as required by § 1.63.
3. The written consent of the assignee, Diversa Corporation.

02/15/2005 MAHMED1 00000069 031952 09751299

01 FC:1464 130.00 DA

sd-244047

4. Copy of Assignment to Diversa Corporation. signed by the Inventors.

5. The fee set forth in 37 C.F.R. § 1.17(i) of \$130.00.

☐ is enclosed

☒ is authorized to be charged to **Deposit Account 03-1952**. A Fee Transmittal (form PTO/SB/17i) is enclosed in duplicate for that purpose.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 564462006600.

It is believed that applicant has complied with requirements and correction of the inventorship in the present application is respectfully requested.

Dated: February 11, 2005

Respectfully submitted,

By 

Laurie L. Hill, Ph.D.

Registration No.: 51,804

MORRISON & FOERSTER LLP
3811 Valley Centre Drive, Suite 500
San Diego, California 92130
(858) 720-7955

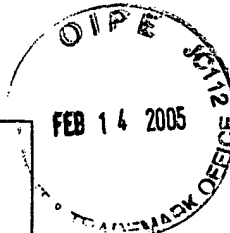
I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: 2/14/05

Signature: 

(Grace T. B.)

FEB 14 2005



Docket No.: 564462006600
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mark MADDEN et al.

Art Unit: 1652

Application No.: 09/751,299

Examiner: K. Kerr

Filed: December 28, 2000

For: METHODS FOR PRODUCING
ENANTIOMERICALLY PURE ALPHA-
SUBSTITUTED CARBOXYLIC ACIDS

STATEMENT IN SUPPORT OF PETITION TO CORRECT INVENTORSHIP
PURSUANT TO 37 C.F.R. § 1.48 (a)


Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

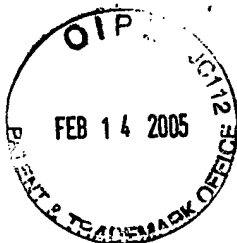
Dear Sir:

I, Dan E. Robertson, declare that in addition to Darcy MADDEN (Heir to Mark MADDEN, deceased), David Paul WEINER, and Jennifer Ann CHAPLIN, I contributed to the invention claimed herein. The omission of my name as an inventor occurred through error and without deceptive intent on my part.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 11/2/04


Dan E. Robertson



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DECLARATION FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:

METHODS FOR PRODUCING ENANTIOMERICALLY PURE ALPHA-SUBSTITUTED CARBOXYLIC ACIDS

the specification of which was filed on December 28, 2000, as Application No. 09/751,299 and amended on May 8, 2001; January 17, 2003; and July 17, 2003.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by an amendment, if any, specifically referred to herein.

I acknowledge the duty to disclose all information known to me that is material to patentability in accordance with Title 37, Code of Federal Regulations, § 1.56.

FOREIGN PRIORITY CLAIM

I hereby claim foreign priority benefits under Title 35, United States Code § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

☒ no foreign applications have been filed

☐ foreign applications have been filed as follows:

**EARLIEST FOREIGN APPLICATION(S), IF ANY FILED WITHIN 12 MONTHS
(6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION**

Application Number	Country	Date of Filing	Priority Claimed Under 35 USC 119
			Yes No

**ALL FOREIGN APPLICATION(S), IF ANY FILED MORE THAN 12 MONTHS
(6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION**

Application Number	Country	Date of Filing

CLAIM FOR BENEFIT OF EARLIER U.S. PROVISIONAL APPLICATIONS

I hereby claim priority benefits under Title 35, United States Code §119(e), of any United States provisional patent application(s) listed below:

☐ no U.S. provisional applications have been filed.

☒ U.S. provisional applications have been filed as follows:

Application Number	Date of Filing	Priority Claimed Under 35 USC 119
60/254,414	12/07/2000	<u> X </u> Yes No <u> </u>
60/173,609	12/29/1999	<u> X </u> Yes No <u> </u>
		<u> </u> Yes No <u> </u>

CLAIM FOR BENEFIT OF EARLIER U.S./PCT APPLICATION(S)

I hereby claim the benefit under Title 35, United States Code, §120 of the United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose all information that is material to patentability in accordance with Title 37, Code of Federal Regulations, §1.56 which became available to me between the filing date of the prior application and the national or PCT international filing date of this application:

☒ no U.S./PCT applications have been filed.

☐ U.S./PCT applications have been filed as follows:

Application Number	Date of Filing	Status (Patented/Pending/Abandoned)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint:

All practitioners at Customer Number 25225

all of **Morrison & Foerster LLP**, 3811 Valley Centre Drive, Suite 500, San Diego, California 92130, jointly, and each of them severally, my attorneys at law/patent agent(s), with full power of substitution, delegation and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the U. S. Patent and Trademark Office connected therewith.

Please mail all correspondence to Gregory P. Einhorn, whose address is:

Morrison & Foerster LLP
3811 Valley Centre Drive, Suite 500
San Diego, California 92130

Please direct telephone calls to: Gregory P. Einhorn at (858) 720-5133.

Please direct facsimiles to: (858) 720-5125

Full name of sole or first inventor Darcy MADDEN (Heir to Mark MADDEN, deceased)	
Sole or first inventor's signature <i>Darcy Madden</i>	Date <i>20 Nov 2004</i>
Residence San Diego, California	
Citizenship US	
Mailing Address 11145 Affinity Court, Unit 26 San Diego, California 92131	

Full name of second inventor, if any David Paul WEINER	
Second inventor's signature <i>David Paul Weiner</i>	Date <i>29th November 2004</i>
Residence Del Mar, California	
Citizenship United Kingdom	
Mailing Address 13416 Portofino Drive Del Mar, California 92104	

Full name of second inventor, if any David Paul WEINER	
Second inventor's signature	Date
Residence Del Mar, California	
Citizenship United Kingdom	
Mailing Address 13416 Portofino Drive Del Mar, California 92104	

Full name of third inventor, if any Jennifer Ann CHAPLIN	
Third inventor's signature <i>Jennifer Ann Chaplin</i>	Date 10/29/04
Residence San Diego, California	
Citizenship US South Africa	
Mailing Address 12537 El Camino Real, #C San Diego, California 92130	

Full name of fourth inventor, if any Dan E. ROBERTSON	
Fourth inventor's signature <i>Dan E. Robertson</i>	Date 11/3/04
Residence	
Citizenship US	
Mailing Address 818 Viva Court 6332 Oleander Way Solana Beach, California 92075 San Diego, California 92130	

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Dated: 2/14/05

Signature: [Signature]
(Grace Yu)



Docket No.: 564462006600
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mark MADDEN et al.

Art Unit: 1652

Application No.: 09/751,299

Examiner: K. Kerr

Filed: December 28, 2000

For: METHODS FOR PRODUCING
ENANTIOMERICALLY PURE ALPHA-
SUBSTITUTED CARBOXYLIC ACIDS

CONSENT OF ASSIGNEE UNDER 37 C.F.R. § 3.73(b)
TO CORRECT INVENTORSHIP

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Diversa Corporation, is the assignee of the entire right, title and interest in the invention claimed in the above captioned U.S. patent application 09/751,299 by virtue of an assignment recorded by the U.S. Patent and Trademark Office on April 27, 2001, with Reel 011755 and Frame 0543. The undersigned, who is authorized to execute this Consent on behalf of Diversa Corporation, states that Diversa Corporation consents to the correction of inventorship to add Dan E. Robertson as a co-inventor.

Executed on JANUARY 17, 2005, at San Diego, California.

Signature: [Signature]

Printed Name: CAROLYN ERICKSON

Title: VICE PRESIDENT,

INTELLECTUAL PROPERTY

COPY

ASSIGNMENT

For valuable consideration, We, Darcy MADDEN (Heir to Mark MADDEN, deceased) of 11145 Affinity Court, Unit 26, San Diego, California 92131; David Paul WEINER of 13416 Portofino Drive, Del Mar, California 92104; Jennifer Ann CHAPLIN of 12537 El Camino Real, #C, San Diego, California 92130; and Dan E. ROBERTSON of 6332 Oleander Way, San Diego, California 92130, hereby assign to DIVERSA CORPORATION, a Delaware corporation having a place of business at 4955 Directors Place, San Diego, California 92121-1609 and its successors and assigns (collectively hereinafter called the "Assignee"), the entire right, title and interest throughout the world in the invention(s) and improvement(s) which are subject of a United States Patent Application entitled METHODS FOR PRODUCING ENANTIOMERICALLY PURE ALPHA-SUBSTITUTED CARBOXYLIC ACIDS, filed December 28, 2000, assigned serial number 09/751,299, and any corresponding applications for United States patents signed by us, WE authorize and request the attorneys appointed in said application to hereafter complete this Assignment by inserting above the filing date and serial number of future related applications when known and to insert on this Assignment any further identification, including any further identification that may be necessary or desirable in order to comply with the rules of the United States Patent and Trademark Office for recordation of this document; and WE authorize and request the attorneys appointed in said application to hereafter insert the filing dates and serial numbers of related converted provisional applications, nonprovisional applications converted to provisional applications, continuations, divisionals, continuations-in-part (CIPs), reissues, reexaminations, and international applications when known. This Assignment includes the application(s) cited herein and any and all related United States patent applications, including converted provisional applications, nonprovisional applications converted to provisional applications, divisionals, reissues, reexaminations, continuations, CIPS, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and We authorize the Assignee to apply in all countries in my name or in its own name for patents, utility models,

design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and We agree for ourselves and our respective heirs, legal representatives, successors and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this Assignment.

In Witness Whereof, I hereto set my hand and seal at San Diego Ca, this
21 day of November, 2004.

Darcy Madden
Darcy MADDEN (Heir to Mark MADDEN, deceased)

In Witness Whereof, I hereto set my hand and seal at _____, this
_____ day of _____, 2004.

David Paul WEINER

In Witness Whereof, I hereto set my hand and seal at _____, this
_____ day of _____, 2004.

Jennifer Ann CHAPLAN

In Witness Whereof, I hereto set my hand and seal at _____, this
_____ day of _____, 2004.

Dan E. ROBERTSON

design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and We agree for ourselves and our respective heirs, legal representatives, successors and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this Assignment.

In Witness Whereof, I hereto set my hand and seal at _____, this
_____ day of _____, 2004.

Darcy MADDEN (Heir to Mark MADDEN, deceased)

In Witness Whereof, I hereto set my hand and seal at San Diego, this
29th day of November, 2004.



David Paul WEINER

In Witness Whereof, I hereto set my hand and seal at San Diego, this
29th day of October, 2004.

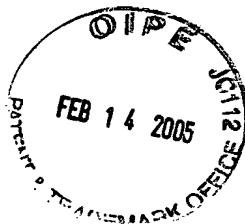


Jennifer Ann CHAPLAN

In Witness Whereof, I hereto set my hand and seal at San Diego, this
2 day of NOVEMBER, 2004.



Dan E. ROBERTSON



Application Data Sheet

Application Information

Application Type::	Regular
Subject Matter::	Utility
Suggested Group Art Unit::	1652
CD-ROM or CD-R?::	None
Sequence submission?::	None
Computer Readable Form (CRF)?::	No
Title::	METHODS FOR PRODUCING ALPHA-SUBSTITUTED CARBOXYLIC ACIDS USING NITRILASES AND STRECKER REAGENTS (AS AMENDED)
Attorney Docket Number::	564462006600
Request for Early Publication?::	No
Request for Non-Publication?::	No
Small Entity?::	Yes
Petition included?::	No
Secrecy Order in Parent Appl.?::	No

Applicant Information

Applicant Authority Type::	Inventor (Mark MADDEN deceased)
Primary Citizenship Country::	US
Status::	Full Capacity
Given Name::	Darcy
Family Name::	MADDEN(Heir to deceased)
City of Residence::	San Diego
State or Province of Residence::	CA
Country of Residence::	US
Street of mailing address::	11145 Affinity Ct. Unit 26
City of mailing address::	San Diego
State or Province of mailing address::	CA

Postal or Zip Code of mailing address:: 92131

Applicant Authority Type:: Inventor
Primary Citizenship Country:: United Kingdom
Status:: Full Capacity
Given Name:: David
Middle Name:: Paul
Family Name:: WEINER
City of Residence:: Del Mar
State or Province of Residence:: CA
Country of Residence:: US
Street of mailing address:: 13416 Portofino Drive
City of mailing address:: Del Mar
State or Province of mailing address:: CA
Postal or Zip Code of mailing address:: 92104

Applicant Authority Type:: Inventor
Primary Citizenship Country:: South Africa
Status:: Full Capacity
Given Name:: Jennifer
Middle Name:: Ann
Family Name:: CHAPLIN
City of Residence:: San Diego
State or Province of Residence:: CA
Country of Residence:: US
Street of mailing address:: 12537 El Camino Real #C
City of mailing address:: San Diego
State or Province of mailing address:: CA
Postal or Zip Code of mailing address:: 92130

Applicant Authority Type:: Inventor
Primary Citizenship Country:: US

Status:: Full Capacity
Given Name:: Dan
Middle Name:: E.
Family Name:: ROBERTSON
City of Residence:: San Diego
State or Province of Residence:: CA
Country of Residence:: US
Street of mailing address:: 6332 Oleander Way
City of mailing address:: San Diego
State or Province of mailing address:: CA
Postal or Zip Code of mailing address:: 92130

Correspondence Information

Correspondence Customer Number:: 45975

Representative Information

Representative Customer Number:: 45975

Domestic Priority Information

Application::	Continuity Type::	Parent Application::	Parent Filing Date::
This Application	An application claiming the benefit under 35 USC 119(e)	60/254,414	12/07/00
This Application	An application claiming the benefit under 35 USC 119(e)	60/173,609	12/29/99

Assignee Information

Assignee name:: Diversa Corporation